

REMARKS

Favorable consideration and allowance are requested for claims 12-30 in view of the following remarks.

Status of the Application

Claims 12-30 are pending in this application. Claims 1-11 were previously canceled. Claim 23 was rejected under 35 U.S.C. § 101. Claims 21 and 22 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0046359 to Betz *et al.* (the “Betz publication”). Claims 12-19 and 23-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,701,492 to Wadsworth *et al.* (the “Wadsworth patent”) in view of U.S. Patent Publication No. 2002/0138592 to Toft (the “Toft publication”). Claims 17-20 were objected to.

Rejection under 35 U.S.C. § 101

According to the Examiner, the invention of claim 23 does not “transform[] article or physical object to a different state or thing” or “otherwise produces a useful, concrete and tangible result.” With respect to both the first and second points, the Examiner stated that “the first data memory and the first volatile data memory are not statutory by” themselves. In response, Applicant respectfully submits that a determination of whether an *invention* constitutes statutory subject matter is not based on an analysis of whether individual claim elements “are . . . statutory.” Therefore, Applicant asserts that the Examiner has failed to make a *prima facie* case that claim 23 does not recite statutory subject matter and, therefore, the rejection should be withdrawn.

Rejection under 35 U.S.C. § 102(e)

According to the Examiner, the Betz publication discloses each of the limitations of claims 21 and 22. The Examiner admitted, however, that the reference does not disclose the presence of a computer-readable memory. For at least this reason, Applicant respectfully submits that the rejection of claims 21 and 22 should be withdrawn.

Further, with respect to claim 22, the Examiner did not present any reasons how the cited references purportedly teach a boot program stored as electronically readable control signals. For this additional reason, the rejection of claim 22 should be withdrawn.

Rejection under 35 U.S.C. § 103(a)

According to the Examiner, the Wadsworth patent discloses loading a non-compressed boot program from flash EPROM to DRAM and then executing the boot program. The Examiner stated that although the Wadsworth patent does not disclose a method of operating the device using compressed data, it would have been obvious to combine the methods therein with those disclosed in the Toft publication.

In response Applicant respectfully submits that the boot program disclosed in the Wadsworth patent is not fully executed from the DRAM:

FIG. 5 is a flow diagram showing operation of the network interface card upon application of power (i.e., boot-up operation). In general, the process steps shown in FIG. 5 operate so that after application of power, *execution begins from a predesignated EPROM address* (the beginning of region 105a) to find the current directory in directory region 103, to read the boot block select field from the current directory region, to copy the selected

boot block from EPROM to DRAM, and to enable a shadow RAM switch so
as to execute the remainder of the boot block out of DRAM.

Wadsworth patent specification at column 11, lines 35 to 44 (emphases added);
see also id. at Fig. 5. This is not the methodology of claim 12.

The Toft publication, which merely discloses the decompression of a stored operating system prior to executing the system, does not disclose the subject matter not recited in the Wadsworth patent. And, in any event, the Examiner has failed to indicate why one of ordinary skill in the art interested in the fail-safe flashing of EPROM of the Wadsworth patent would look to the Toft publication for any reason, let alone to decompress data. Therefore, Applicant respectfully submits that the Wadsworth patent and the Toft publication, either alone or in combination, fail to disclose or suggest the subject matter of claim 12, and, as a result, the rejection of this claim should be withdrawn. As claims 13-19 depend directly or indirectly from claim 12, the rejection of these claims should also be withdrawn. (Applicant notes that claim 20 appears to have been erroneously listed in this rejection given the Examiner's indication elsewhere in the Office Action that it contains allowable subject matter.) As no separate reasons were given by the Examiner for the rejection of apparatus claims 23-30, Applicant submits that the rejection of these claims be withdrawn as well.

Applicant gratefully acknowledges the indication of allowable subject matter in claims 17-20 if the claims were rewritten in independent form. In response, as these claims depend directly or indirectly from independent claim

12, Applicant respectfully asserts that the claims are allowable in their current form for the reasons discussed above.

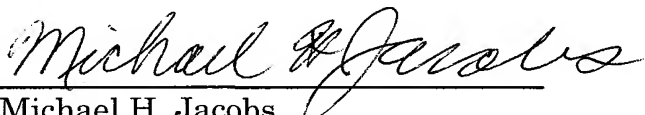
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If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #010408.52554US).

Respectfully submitted,

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